

REMARKS

Claims 1, 24 and 27 are amended herein. No new matter is presented in any of the foregoing and, accordingly, approval and entry of the amended claims are respectfully requested.

Claim 30 is withdrawn by the Examiner. Claims 1, 3-12 and 18-29 are pending and under consideration.

STATEMENT ON SUBSTANCE OF INTERVIEW

An in-person interview was conducted between the Applicant's representative and the Examiner to discuss features of the present invention that patentably distinguish over the cited art. Applicant thanks the Examiner for the opportunity to conduct the interview.

ITEM 3: WITHDRAWAL OF CLAIM 30

In item 3, the Examiner contends:

claim 30 is directed to an invention that is independent or distinct from the invention originally claimed . . . recites the new feature of controlling power level of two pulses of multiple pulse train relative to a peak power of a third pulse, which never been claimed before and this feature is distinct from the invention originally claimed by claims 1,3-12,18-29.

Applicant respectfully submits that these features are not distinct and points out to the Examiner that claim 29, for example, recites "a pulse train for the current mark comprising a first pulse, a multi-pulse having a peak power level, and a last pulse; . . . adapting the first and last pulses relative to the multi-pulse depending on the correlations and adapting the multi-pulse power level relative to a predetermined value depending on the size of the current mark." that is, controlling power level of two pulses of multiple pulse train relative to a peak power of a third pulse.

Applicant respectfully requests that that examiner reconsider the withdrawal of claim 30.

ITEM 10: ALLOWABLE SUBJECT MATTER

Claim 29 is allowed. (Action at page 4). Applicant appreciates the indication of allowable subject matter.

ITEM 7: REJECTION OF CLAIMS 18-20 AND 26 UNDER 35 U.S.C. §102(b) AS BEING ANTICIPATED BY (APA)

The Examiner rejects independent claims 18 (and dependent claims 19-20 and 26) under 35 U.S.C. §102(b) as being anticipated by APA. (Previous Action at pages 4-9). The rejection is traversed.

In support of the rejection, the Examiner relies on, and incorrectly cites, "specification, page 6, paragraph [0025]" as admitted prior art. (Previous Action at page 6).

However, Applicant submits that paragraph [0025] is not admitted prior art, and is not correctly relied on by the Examiner in support of the rejection.

Rather, paragraph [0025] is in the section of the present application entitled "DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENTS," and clearly not admitted prior art, as the Examiner contends.

Summary

Since features recited by independent claim 18 (and dependent claims 19-20 and 26) are not discussed by any prior art able to be relied on by the Examiner, the rejection should be withdrawn and claims 18-20 and 26 allowed.

ITEM 7: REJECTION OF CLAIMS 1, 3-12, 24-25, AND 27-28 UNDER 35 U.S.C. §102(b) AS BEING ANTICIPATED BY APPLICANT'S PRIOR ART (FIGS. 1A, 1B, 2, 3A, 3B AND 7-9) (APA)

The Examiner rejects independent claims 1, 24, and 27 (and dependent claims 3-12, 25, and 28) under 35 U.S.C. 102(b) as being anticipated by APA for reasons set forth in the previous Office Action mailed May 27, 2005. (Previous Action at pages 4-9). The rejection is traversed.

During the in-person interview, and as indicated in the present Action, the Examiner contends that features distinguishing FIGs. 6A and 6B are required to be recited in claims so as to distinguish from the prior art, i.e. FIGs. 3A and 3B.

Applicant's respectfully submit that such distinguishing features are recited in claims independent claims 1, 24, and 27, all as amended.

Claim 1, for example, recites a method comprising "forming a mark using a multiple pulse train comprising a first pulse, a multi-pulse having a peak power level, and a last pulse; adapting a power level of the first pulse relative to the peak power level of the multi-pulse depending on a correlation between the mark and a previous space; adapting a power level of the last pulse relative to the peak power level of the multi-pulse depending on a correlation between the mark and a next space and independently of the adapting the power level of the first pulse." (Emphasis added).

The Examiner contends:

forming a mark using a multiple pulse train comprising a first pulse, a multi-pulse having a peak power level and a last pulse (is discussed by) (Fig. 3A, first pulse at beginning of pulse chain, multi-pulse in the middle of pulse chain and last pulse at the end of pulse chain);

adapting a power level of the first pulse relative to the peak power level of the multi-pulse depending on a correlation between the mark and a previous space (is discussed by) (Fig. 3A, the changed depending on combination of previous space and current mark)

adapting a power level of the last pulse relative to the peak power level of the multi-pulse depending on a correlation between the mark and a next space (is discussed by) (Fig. 3A, the changed depending on combination of current mark and next space).

(Previous Action at pages 4-5).

Applicant submits that the Examiner's contentions are incorrect. That is, the claim must be considered as a whole, but the Examiner is instead incorrectly separating and reconstructing features illustrated in FIG. 3A to support the rejection.

FIG. 3A does not discuss "forming a mark using a multiple pulse train comprising a first pulse, a multi-pulse having a peak power level, and a last pulse; adapting a power level of the first pulse (that is, the same first pulse) relative to the peak power level (that is, the same peak power level) of the multi-pulse (that is, the same multi-pulse) depending on a correlation between the mark (that is, the same mark) and a previous space; adapting a power level of the last pulse (that is, the same last pulse) relative to the peak power level (that is, the same peak power level) of the multi-pulse (that is, the same multipluse) depending on a correlation between the mark (that is the same multi pulse) and a next space and independently of the adapting the power level of the first pulse.

FIG. 3A also does not discuss a method, as recited by independent claim 24, as the Examiner contends, "providing a different reference power level to each multi-pulse train . . . based on a correlation between a current mark and a space between successive marks." (Emphasis added). FIG 3A also does not discuss, as recited by independent claim 27 "adapting a power level of at least one of the first pulse and the last pulse relative to a peak power level of the multi-pulse depending on a correlation between the mark and one of a previous space and a next space."

Rather, FIG. 3A merely discusses:

a first multiple pulse train, the power level of a first pulse is adjusted according to a combination of a previous space and a current mark. In a second multiple pulse train, the power level of a last pulse is adjusted depending on a correlation between a current mark and a next space. In a third multiple pulse train, the power levels of first and last pulses are adjusted depending on the size of a current mark regardless of a correlation between a mark and a space.

(Emphasis added, see, paragraph [0025]).

That is FIG. 3A discusses three separate multiple pulse trains from which the Examiner is incorrectly combining the features to support the rejection.

Summary

Since features recited by claims 1, 3-12, 24-25, and 27-28 are not discussed by the art relied on by the Examiner, the rejection should be withdrawn and claims 1, 3-12, 24-25, and 27-28 allowed.

ITEM 9: REJECTION OF CLAIMS 21-23 UNDER 35 U.S.C. 103(a) AS BEING UNPATENTABLE OVER APA

The Examiner rejects dependent claims 21-23 under 35 U.S.C. §103(a) as being unpatentable over APA for the "same reasons set forth in the last Office action (paragraph (7) of the papers mailed on 5/27/2005).

Applicant respectfully points out that the rejection and support for the rejection of claims 21-23 under 35 U.S.C. §103(a) as being unpatentable over APA was in item 9, pages 9-10 of the previous Office Action, and Applicant traverses the rejection accordingly.

Claims 21-23, using claim 21 as an example, recite a method wherein "said multi-pulse reference power level is greater than said first pulse power level and less than said last pulse power level."

In item 9 of the previous Office Action the Examiner states that APA does not discuss "multi-pulse reference power level is greater than first pulse power level and less than last power level." However, the Examiner contends it would have been obvious "to adjust the power level of multi-pulse to be greater/lower (than the) first or last pulse." (Previous Action at page 10).

The Applicant respectfully traverses the Examiner's statement and demands the Examiner produce authority for the statement. The Applicant specifically points out the following errors in the Examiner's action. First, the Examiner uses common knowledge as the principal evidence for the rejection. As explained in M.P.E.P. § 2144.03(E):

any facts so noticed should . . . serve only to 'fill in the gaps' in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.

Second, the noticed fact is not considered to be common knowledge or well-known in the art. In this case, the feature is not of notorious character or capable of instant and unquestionable demonstration as being well-known. Instead, this feature is unique to the

present invention. See M.P.E.P. § 2144.03(A) ("the notice of facts beyond the record which may be taken by the Examiner must be "capable of such instant and unquestionable demonstration as to defy dispute").

Third, it appears that the Examiner also bases the rejection, at least in part, on personal knowledge. The Examiner is required under 37 C.F.R. § 1.104(d)(2) to support such an assertion with an affidavit when called for by the Applicant. Thus, Applicant calls upon the Examiner to support such assertion with an affidavit.

Further, Applicant submits that the Examiner is incorrectly modifying the APA. As provided in MPEP §2144. 04:

(the mere fact that a worker in the art could rearrange the parts of the reference device . . . is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation . . . without the benefit of appellant's specification, to make the necessary changes in the reference device.

(Emphasis added).

Summary

Since the Examiner's statement is unsupported and *prima facie* obviousness is not established, the rejection should be withdrawn and claims 21-23 allowed.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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By: Paul W. Bobowiec
Paul W. Bobowiec
Registration No. 47,431

1201 New York Ave, N.W., Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501